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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,074	07/30/2001	Jurgen Beil	534P008	2565
42754	7590	07/07/2008		
Nields & Lemack 176 E. Main Street Suite #5 Westboro, MA 01581			EXAMINER HAYES, BRET C	
			ART UNIT 3641	PAPER NUMBER
			MAIL DATE 07/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/918,074	BEIL, JURGEN	
	Examiner	Art Unit	
	Bret Hayes	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 8-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the decision entered 20 JUN 08. Based upon the BPAI's encouragement to "conduct a further search," prosecution has been reopened. The directors approval is indicated below:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 17 recites the limitation "said baits" and "said bait" in lines 1 and 2. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7, 13, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,775,023 to Botkins.

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7. Re claim 1, Botkins discloses the claimed invention including a method for producing aromatic and/or enticing articles and parts thereof, comprising treating a material **14** comprising porous*, thermoplastic plastic with at least one fish-luring aromatic and/or enticing substance, as set forth at col. 3, lines 30 – 35. *This is asserted because Botkins discloses at line 32 that polyolefin may be used in the manufacture, and, because applicants Claim 7 recites that the material can be polyolefin. If the material as claimed is clearly disclosed in the reference, then the reference inherently anticipates any known characteristics of that material as well. As to limitations which are considered to be inherent in a reference, note the case law of *In re Ludtke*, 169 USPQ 563, *In re Swinehart*, 169 USPQ 226, *In re Fitzgerald*, 205 USPQ 594, *In re Best et al.*, 195 USPQ 430, and *In re Brown*, 173 USPQ 685, 688.
8. Re claim 7, as dependent upon claim 1, Botkins discloses polyolefin above.
9. Re claim 13, Botkins further discloses adhering, welding, heat-shaping and/or printing said material before it is treated with said fish-luring aromatic and/or enticing substance. In the citation above, Botkins discloses that the material is fabricated by a molding operation, which anticipates at least ‘heat-shaping’ above.
10. Re claims 14 and 16, Botkins discloses the claimed invention as element **14** as above.
11. Re claim 17, Botkins further discloses the articles selected from the group consisting of fish-catching devices, feed baskets, buoyancy blocks for fish-catching nets, basic lead sheathings, blinker casings, spinner casings, twisters and parts thereof. In that Botkins discloses material **14** to be a sleeve, it anticipates at least ‘parts thereof’ as claimed.
12. Claims 1 – 5, 7 and 13 – 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,708,903 to Bercz et al. (*Bercz*).

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13. Re claim 1, Bercz discloses the claimed invention including a method for producing aromatic and/or enticing articles and parts thereof, comprising treating a material **30, 52, 168, 170, 172**, Figs. 1 – 4 and 12, for example, comprising porous*, thermoplastic plastic, as set forth at least at col. 3, lines 14 – 24, with at least one fish-luring aromatic and/or enticing substance, the chemiluminescent material disclosed above. *With respect to being porous, Bercz discloses the material being gas permeable, which anticipates being porous as claimed.

14. Anent claims 2 – 5, Bercz discloses the claimed invention as applied above. The least diameter disclosed by Applicant for the average size of the pores is 0.1 μm . Bercz discloses the “gases [being] common to that of normal atmosphere,” at lines 10 and 11. Gases common to normal atmosphere include about 78% Nitrogen, 21% Oxygen and the remainder mainly Argon and Carbon Dioxide with less than 0.002% comprising other trace elements. In order to disallow even the largest of these gas molecules, presumably CO_2 , for example, the pores would need to be much less than 200 picometers (pm) in diameter, since it is known that CO_2 is actually only about 163 pm across*. 163 pm is equivalent to 0.000163 μm . Clearly then, allowing gases common to normal atmosphere anticipates the limitation of the least diameter of the pores being 0.5 μm , and, therefore, also the greater diameters claimed. *With respect to this assertion, support can be found on the internet in a search for “co2” of the site for Wikipedia.

15. Re claim 7, Bercz discloses polyethylene, see above, which anticipates at least polyolefin because polyethylene is a polyolefin.

16. Re claim 13, Bercz further discloses adhering, welding, heat-shaping and/or printing said material before it is treated with said fish-luring aromatic and/or enticing substance. In the

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citation above, Bercz discloses that the material is stuck fast by snap-action, col. 3, lines 9 – 13, which anticipates at least ‘adhering’ above.

17. Re claims 14 – 16, Bercz discloses the claimed invention as applied above.

18. Re claim 17, Bercz further discloses the articles selected from the group consisting of fish-catching devices, feed baskets, buoyancy blocks for fish-catching nets, basic lead sheathings, blinker casings, spinner casings, twistlers and parts thereof. In that Bercz discloses material **30, 52, 168, 170, 172**, Figs. 1 – 4 and 12, for example, to be a cover, it anticipates at least ‘parts thereof’ as claimed.

19. Re claim 18, Bercz discloses a method of luring fish, comprising placing a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance in a body of water containing fish, as discussed above.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Botkins or Bercz as applied above.

22. Botkins and Bercz discloses the claimed invention including the material inherently having a void volume, except for that volume being at least 50% as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manipulate the void volume to be at least 50% as claimed, since it has been held that discovering an

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optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In this case, one of ordinary skill in the art would understand that such a manipulation would help define critical characteristics of the device.

Further, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1742 (2007). That being said, to manipulate the void volume to enhance desired characteristics, would be obvious to try to manipulate such.

Allowable Subject Matter

23. Claims 8 – 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov, which is preferred. The examiner can normally be reached Monday through Friday from 5:30 am to 2:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

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/Bret Hayes/

Primary Examiner, Art Unit 3641

3-Jul-08

/Wynn W. Coggins/

Director, TC 3600